

### **REMARKS**

Applicant has carefully considered the rejections made in the Office Action mailed December 9, 2008 (the "Office Action"). Claim 1 has been amended to clarify the various steps required by the claimed process. No new steps have been added and no old steps have been deleted. Accordingly, applicant respectfully submits that a request for continued examination is not required.

Claims 1-9 are pending in this application and stand rejected. Applicant respectfully submits that in view of the amendments made, and the remarks that follow, the application is in condition for allowance. Applicant earnestly solicits the Examiner for a Notice of Allowance.

#### **I. 35 U.S.C. § 101**

Applicant respectfully traverses the Office Action's rejection of claims 1-9 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Rather, claims 1-9 are directed to a process that comprises an installer exerting a manual first action on an element, the element interpreting the manual first action as an interrogation concerning the element's state of membership in a group, the manual first action triggering the emission of an information signal from the element, the installer exerting a manual following action on the element, and the element interpreting the manual following action as an order for modifying the element's state of membership in the group. Accordingly, applicant respectfully submits that claims 1-9 are directed to statutory subject matter.

35 U.S.C. § 101 states that "any new and useful process" may be patentable. Claims 1-9 are directed to a new and useful "process for assembling a group of networked elements controlling equipment of a building." Furthermore, applicant respectfully submits that claims 1-9 do not fall within any judicial exception to § 101, including a natural phenomenon. The United States Court of Appeals for the Federal Circuit recently reaffirmed the test for patent-eligible subject matter in *In re Bilski*:

A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state of thing.

*In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008).

Claims 1-9 are clearly tied to a particular machine or apparatus: an element controlling equipment of a building. That is, the claimed invention requires “an installer exerting a manual first action on one of the elements; the element interpreting the manual first action as an interrogation of the element . . . ; the manual first action triggering the emission of an information signal from the element . . . ; the installer exerting a manual following action on the element; and the element interpreting the manual following action as an order for modifying the element’s state of membership in the group.” (claim 1) (emphasis added).

In an interview conducted by the undersigned on March 4, 2009, the Office explained that it thought the rejection of claims 1-9 under § 101 was proper because the claims required a “manual first action” and “a manual following action.” However, no authority was provided in either the Office Action or the interview for the proposition that a new and useful process is directed to non-statutory subject matter because it recites a manual action. Applicant respectfully traverses this rejection.

It has long been understood that “successive mechanical steps, taken by an automatic machine or by the human operator, may be patentable as an art.” *Gas Machinery Co. v. United Gas Improvement Co.*, 228, F. 684, 691 (6th Cir. 1915) (emphasis added) (citing *Expanded Metal Co. v. Bradford Co.*, 214 U.S. 366, 382 (1909)). In *Expanded Metal*, the Supreme Court cited to Walker on Patents, 4th ed. § 3 for the basic proposition that “valid process patents may be granted for ‘operations which consist entirely of mechanical transactions, but which may be performed by hand or by any of several different mechanisms or machines.’” *Expanded Metal*, 214 U.S. 366, 383 (emphasis added). “Indeed, it is possible for a statutory ‘process’ to be performed manually.” *Ex Parte Lundgren*, 2005 Pat. App. LEXIS 34 (B.P.A.I. Sept. 28, 2005) (Barrett, A.L.J., concurring-in-part and dissenting-in-part).

This law is reflected in the law of the Federal Circuit which explained in *In re Allapat*, 33 F. 3d. 1526, 1569 (Fed. Cir. 1994), “[i]t is not relevant to section 101 whether the structure is hardwired or programmed, machine-readable or manually performed . . . .”

Numerous patents issued by the United States Patent Office confirm this fact, and below are discussions of a few recent examples:

- U.S. Patent No. 7,500,238 (“the ‘238 patent”) issued on March 3, 2009 to Nestoryak for a “Method and System for Installing a Software Platform onto a Computer System.” Claim 1 of the ‘238 patent requires, in part, “designating, by a user, a computer system and a software platform of a plurality of software platforms to be installed on the designated computer system using a graphical user interface.” (emphasis added). That is, the claimed method requires a manual action by a user.
- U.S. Patent No. 7,489,313 (“the ‘313 patent”) issued on February 10, 2009 to Kaus et al. for a “Method of Segmenting a Three-Dimensional Data Set Allowing User Corrections.” Claim 1 of the ‘313 patent requires, in part, “manual displacement of nodes.” (emphasis added). That is, the claimed method requires a manual action by a user.
- U.S. Patent No. 6,268,227 (“the ‘227 patent”) issued on April 9, 2002 to Olson for a “Method of Swinging on a Swing.” Claim 1 of the ‘227 patent requires, in part, “having the user pull alternately on one chain to induce movement of the user and the swing toward one side, and then on the other chain to induce movement of the user and the swing toward the other side.” (emphasis added).<sup>1</sup> That is, the claimed method requires a manual action by a user.

These patents are only a few examples of patents issued by the United States Patent Office claiming methods that require a manual action by a user. Applicant respectfully asserts that the issuance of these patents is inconsistent with the Office Action’s assertion that claims are not patentable-eligible under § 101 if they require a manual action.

For at least these reasons, applicant respectfully submits that claims 1-9 are directed to patent-eligible subject matter under § 101 are not directed to any judicial

---

<sup>1</sup> While claims 1-4 of the ‘227 patent were cancelled in a subsequent reexamination, they were cancelled on the basis of obviousness under 35 U.S.C. § 103 and not for claiming non-statutory subject matter under 35 U.S.C. § 101.

exception. While the claimed invention requires an installer exerting a manual first action and a manual following action, the claims are tied to a particular machine or apparatus - an element that can be grouped in a network of elements. Accordingly claims 1-9 contain patent-eligible subject matter under 35 U.S.C. § 101 and *In re Bilski*. Therefore, applicant respectfully requests allowance of these claims.

## **II. 35 U.S.C. § 103**

Applicant respectfully traverses the Office Action's rejection of claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over Myer. Unlike the claimed invention, one embodiment of Myer discloses a method of controlling devices that includes sending a message to all compatible devices to change the link state of the devices to an identification mode. The change to identification mode "activates an indicator such as a flashing LED on each eligible device." Myer, col. 7, ll. 60-61. That is, once a device is toggled to an identification mode in Myer, a flashing LED is activated on the device. Even if some devices are already attached to their respective software objects in Myer, when the remaining unattached objects are toggled to an identification mode, LEDs on the unattached objects are caused to flash by the switch to identification mode.

Conversely, the claimed invention requires, in part, that "the emission of the information signal from the element is triggered only by the manual first action being exerted on the element." (claim 1) (emphasis added). That is, an element of the claimed invention does not emit an information signal merely because it is placed in a learning mode. Rather, only exerting a manual first action on the element causes the element to emit an information signal.

In a second embodiment of Myer, a management message is sent to a device to activate the device and provide a visual indication of the device. However, as explained in Myer, in this embodiments the "no manual intervention is required." Myer, col. 8, ll. 39-40. Accordingly, there can be no "exerting a manual first action on one of the elements" or "exerting a manual following action on the element" as required by the claimed invention.

Furthermore, even the second embodiment of Myer does not conserve total power consumption. Rather, once a device is set to the link state, the visual indicator on

that device is activated. Therefore, if, for example, a user is not in a position to see the device when the device is set to the link state, the device will continue to flash its LED, for example, until the user moves into position to see the device and makes a determination on whether the device is the desired device.

Conversely, elements of the claimed invention do not emit an information signal until a manual first action is exerted on the element. Because a manual action is required, a user can ensure that he is in position to see and evaluate the element as soon as the information signal is emitted. Accordingly, emissions of signals are limited and the total power consumption is conserved. This is an advantage over Myer.

Applicant respectfully submits that it would not have been obvious to a person having ordinary skill in the art at the time of the invention to modify Myer so that a device in Myer only flashed its LED when a manual first action was exerted on the device. Rather, in the first embodiment of Myer, the devices flash their LEDs as soon as they are toggled to an identification mode. This embodiment of Myer teaches away from the claimed invention and modifying this first embodiment of Myer would require an improper fundamental change to the way the devices in Myer function.

In the second embodiment of Myer, once a device is set to the link state, the visual indicator on the device is activated. While only one device's visual indicator is activated at a time in the second embodiment of Myer, in this embodiment, no manual intervention is required. Accordingly, the method according to the second embodiment of Myer is quite different and unlike the claimed process of the present application. Furthermore, one of ordinary skill in the art would have had no motivation, absent the present disclosure, to modify the Myer method to require the exertion of a manual action to control the activation of the devices' visual indicators. Such hindsight reconstruction is improper.

For at least these reasons, applicant respectfully submits that claims 1-9 are not obvious over Myer. Therefore, applicant respectfully requests allowance of these claims.

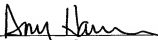
**III. Closing Remarks**

For the foregoing reasons, applicant submits that the subject application is in condition for allowance and respectfully requests allowance of the application. Should the Examiner be of the opinion that a telephone conference would expedite the prosecution hereof, the Examiner is respectfully requested to call the undersigned at the below-listed number.

The Commissioner is hereby authorized to charge any additional fee which may be required for this application under 37 C.F.R. §§ 1.16-1.18, including but not limited to the issue fee, or credit any overpayment, to Deposit Account No. 23-0920. Should no proper amount be enclosed herewith, such as a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920.

Respectfully submitted,

Dated: March 13, 2009

By   
Erik B. Flom, Reg. No. 41,021  
Amy J. Hammer; Reg. No. 61,048  
HUSCH BLACKWELL SANDERS  
WELSH & KATZ  
120 South Riverside Plaza, 22<sup>nd</sup> Floor  
Chicago, Illinois 60606  
Phone: (312) 655-1500  
Fax: (312) 655-1501